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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,828	06/23/2003	Guo Rui Deng	216683-114025	9067

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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04/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/601,828	Applicant(s) DENG ET AL.	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 17-19, 33-49 and 51-67 is/are pending in the application.
- 4a) Of the above claim(s) 33-35, 37-39, 41, 42 and 51-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 17-19, 36, 40 and 43-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on September 15, 2008 has been entered.

Election/Restrictions

2. Claims 54, 56, 58 and 60-67 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention of Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 2, 2004.

Further, newly submitted claims 55, 57, 59 and 67 (e.g., new Group VIII) are directed to an invention that is independent or distinct from the invention originally claimed and elected (Group III) for the following reasons:

The inventions Groups III and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of the Group I has separate utility such as without the release pad of Group VIII.

Conversely, the subcombination of Group VIII has separate utility such as without the specific cover/housing configuration of Group III. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-67 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 17-19, 40 and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sarka et al., pn 3,863,550 in view of at least one

of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827 or, in the alternative, under 35 U.S.C. 103(a) as obvious over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827, and further in view of Beroz et al., pn 6,543,131.

Regarding claims 1, 18, 19, 40, 45-47 and 49, Sarka discloses an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention including at least one metal base portion/metal plate (e.g., 2), at least one metal blade (e.g., 15) having at least one exposed cutting edge (e.g., 17), and a covering/housing/adapter (e.g., 21, 22). Further, Sarka meets the limitation of "fixedly attaching" in that when the plastic filler material is injected to fill the space and then cured as described (e.g., see col. 4, lines 2-13), the inner assembly will become stuck or held in place within the fixture and thus "fixedly attached to" the fixture, whereby a force will be necessary to remove the assembly from the fixture. Further, it is respectfully submitted that the added limitations "such that said covering translates pressing force applied thereon to be more uniformly applied at the at least one cutting edge along an edge of said at least one blade" does not clearly imply any additional structure but rather merely describes an intended use of the device shown in Fig. 11 of Sarka.

In the alternative, if it is argued that there is no explicit disclosure that the assembly will become fixedly attached fixture, it would have been obvious to one having ordinary skill in the art to use adhesive (e.g., two-sided adhesive tape or a mass of adhesive material) to affix the assembly, particularly plate 2, in the fixture to facilitate

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assembly of the die disclosed in Sarka. One having ordinary skill in the art would be very familiar with the use of such adhesive in the assembly arts and know that it is often applied to assist in assembling of components; for example, such adhesive would be applied between the bottom plate 2 and the bottom 21 of the molding fixture to maintain the respective positions of the die components and the molding fixture during assembly, whereby after assembly, the die would be removed from the molding fixture and the adhesive removed. Beroz discloses one example of the use of such an adhesive to temporarily hold components in place during assembly (e.g., see Figs. 9, 10 and col. 7, lines 23-27; col. 15, lines 26-33). Therefore, it would have been obvious to one having ordinary skill in the art to attach the covering to the metal base portion in Sarka for at least the benefits described above.

Sarka lacks the specific blade configuration, specifically said at least one metal blade forming an enclosed shape. However, it is old and well known in the art to provide such blade configurations based on the desired product configuration. Phillips '933, Phillips '421 and Kang disclose just a few examples of such a blade configuration that includes an enclosed shape. Therefore, it would have been obvious to one having ordinary skill in the art to provide a blade shape having any desired shape including an enclosed shape to produce the desired product.

Regarding claims 17, 43, 44 and 48, the combination teaches an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention but lacks the covering/housing/adaptor being made of a material softer than the metal plate, specifically plastic. However, it is old and well known in the art that plastic provides

various well known benefits including an inexpensive, light weight material that is easy to manufacture and handle. Further, it has been held that the selection of a known material on the basis of suitability for the intended use would be entirely obvious (see *In re Leshin*, 125 USPQ 416 (CCPA 1960)). Therefore, it would have been obvious to one having ordinary skill in the art to make the molding fixture disclosed in Sarka from plastic to gain the well known benefits including those described above.

5. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827 or, in the alternative, under 35 U.S.C. 103(a) as obvious over the combination of Sarka et al., pn 3,863,550 in view of at least one of Phillips et al., pn 2,885,933 (hereafter Phillips '933), Phillips et al., pn 2,993,421 and Kang, pn 4,12,827, and further in view of Beroz et al., pn 6,543,131, and further in view of Johnson, pn 6,658,978.

The combination teaches an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention but lacks the at least one metal base portion and the blade being welded together. However, it is old and well known in the art to weld a blade to a metal base portion, particularly in die structures, as being one of many known ways to provide a secure connection therebetween. Welding provides various well known advantages; for example, it is relatively inexpensive and tooling to perform such tasks is readily available. Johnson (e.g., Fig. 4) provides one example of such welding. Therefore, it would have been obvious to one having ordinary skill in the art to

weld the at least one metal base portion and the blade being together for the well known benefits including those described above.

Response to Arguments

6. Applicant's arguments filed September 15, 2008 have been fully considered but they are not persuasive.

It is respectfully submitted that the Examiner maintains his position regarding the prior art rejection. It is noted that in the argument in the last paragraph of page 10 of the subject response, applicant argues that:

"The molding fixture of Sarka is used during the manufacturing but is then not used with, or part of, the die board."

However, the Examiner respectfully submits that it is well settled case law that a claimed apparatus/device cannot be patentably distinguished with respect to the prior art solely by how the device/apparatus is used. It has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
April 6, 2009